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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,282	07/22/2002	Guy Krippner	150070.402USPC	8714
500	7590	08/15/2006	EXAMINER	
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 6300 SEATTLE, WA 98104-7092			BALASUBRAMANIAN, VENKATARAMAN	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/088,282

Applicant(s)

KRIPPNER ET AL.

Examiner

Venkataraman Balasubramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-13,15-17,19-27 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4-13,15-17,19-27, 30 and 31 is/are allowed.
- 6) ☐ Claim(s) 32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' response, which included amendment to claim 27 and cancellation of claim 28 filed on 6/2/2006, is made of record. Claims 1, 2, 4-13, 15-17, 19-27 and 30-33 are now pending. In view of applicants' amendment to all pending claims, the 112 rejection of claims 27, 28 and 31 made in the previous office action have been obviated. However, the following new ground of rejection applies.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 32 and 33 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for diagnosis HRV infection of respiratory tract does not reasonably provide enablement for diagnosis of any or all picornavirus infections. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Following reasons apply.

The instant claim 32 and 33 are drawn to "diagnosis of a picornavirus infection". Instant claims, as recited, are reach through claims. A reach through claim is a claim drawn to a mechanistic, receptor binding or enzymatic functionality in general format and thereby reach through a scope of invention for which they lack adequate written description and enabling disclosure in the specification.

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In the instant case, based on the HRV capsid binding property of the instant the instant compounds, claims 32 and 33 reach through diagnosis of any or all picornavirus infections in general and thereby they lack adequate written description and enabling disclosure in the specification.

More specifically, in the instant case, based on the mode of action of instant compounds as inhibitor of HRV, based on limited assay showing inhibition of HRV infection of lung provided in the specification (page 58), it is claimed that diagnosis of any or all picornavirus infections in general, for which there is no enabling disclosure.

The instant compounds are disclosed to have HRV inhibitory activity due to capsid binding and it is recited that the instant compounds are useful in diagnosis of any picornavirus infection, for which applicants provide no competent evidence. The fact that a single class of compounds can be used diagnosis of any or all picornavirus infections are new finding for which there is no support in the prior art. Furthermore, the instant compounds are based on the capsid binding property modeled on HRV as evident from pages 1-6 of the specification. There is no evidence provided that would extrapolate such a property to any or picornavirus in general. In addition, the instant compounds, which are said to be derived from, the prior art compound, distinctly show different activities as indicated in page 26 (category A & B). Thus, there is no showing that the instant compounds would behave similarly for any or all picornavirus.

Note substantiation of utility and its scope is required when utility is "speculative", "sufficiently unusual" or not provided. See *Ex parte Jovanovics*, 211 USPQ 907, 909; In

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re Langer 183 USPQ 288. Also note Hoffman v. Klaus 9 USPQ 2d 1657 and Ex parte Powers 220 USPQ 925 regarding type of testing needed to support in vivo uses.

Next, applicant's attention is drawn to the Revised Interim Utility and Written Description Guidelines, at 64 FR 71427 and 71440 (December 21, 1999) wherein it is emphasized that 'a claimed invention must have a specific and substantial utility'. The disclosure in the instant case is not sufficient to enable the instantly claimed diagnosis of any picornavirus infections solely based on the inhibitory activity disclosed for the compounds. The state of the art is indicative of the requirement for undue experimentation. See Hayden , F. G., Review in Medical Virology, 14, 17-31, 2004, wherein with regards to HRV therapies, it is stated that "Unfortunately, no safe and effective HRV-specific antiviral agents are currently available for treatment or prevention of HRV illness. An important limitation of the available data regarding HRV infection in most target populations is the lack of information regarding viral dynamics, specifically quantitative infectious viral levels at different sites (upper versus lower respiratory tract) and time points in illness. Consequently, the importance of ongoing viral replication in disease pathogenesis has not been defined for most of the lower respiratory syndromes associated with HRV. In this regard, controlled studies with selective antiviral agents would be helpful in assessing the contribution of HRV infections to lower respiratory tract disease in many target groups.

In evaluating the enablement question, several factors are to be considered. Note *In re Wands*, 8 USPQ2d 1400 and *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or

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lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

1) The nature of the invention: Use of the compounds in diagnosis of any or all picornavirus infections.

2) The state of the prior art: A very recent publication expressed that the antiviral effects of HRV inhibitors are unpredictable.

3) The predictability or lack thereof in the art: Applicants have not provided any competent evidence or disclosed tests that are highly predictive for the pharmaceutical use for diagnosis of any or all picornavirus of the instant compounds. Pharmacological activity in general is a very unpredictable area. Note that in cases involving physiological activity such as the instant case, "the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved". See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

4) The amount of direction or guidance present and 5) the presence or absence of working examples: Specification has no working examples to show diagnosis of any or all picornavirus infection and the state of the art is that the effects of picornaviral inhibitors are unpredictable.

6) The breadth of the claims: The instant claims embrace diagnosis of any or all picornavirus infections

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7) The quantity of experimentation needed would be an undue burden to one skilled in the pharmaceutical arts since there is inadequate guidance given to the skilled artisan, regarding the pharmaceutical use, for the reasons stated above.

Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims. In view of the breadth of the claims, the chemical nature of the invention, the unpredictability of enzyme-inhibitor interactions in general, and the lack of working examples regarding the activity of the claimed compounds towards diagnosis of the variety of viral infections of the instant claims, one having ordinary skill in the art would have to undergo an undue amount of experimentation to use the instantly claimed invention commensurate in scope with the claims.

MPEP 2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here. Thus, undue experimentation will be required to make Applicants' invention.

#### ***Allowable Subject Matter***

Claims 1, 2, 4-13, 15-17, 19-26, 27, 30 and 31 would be allowable. Said claims would be allowed since specific species and composition embraced in these claims are not taught or suggested by the art of record or from a search in the relevant art area.

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### **Conclusion**

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

  
Venkataraman Balasubramanian

8/14/2006